

BASKET NO.: ORTU-0007

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Robert Raffa, et al.

Application No.: 10/761,096

Filing Date: January 20, 2004

For: COMPOSITIONS COMPRISING A TRAMADOL MATERIAL AND
ACETOMINOPHEN AND ITS USE

Confirmation No.: Not Yet Assigned

Group Art Unit: Not Yet Assigned

Examiner: Not Yet Assigned

DATE OF DEPOSIT: March 11, 2004

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Elizabeth A. McLoud

TYPED NAME: Elizabeth A. McLoud

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Pursuant to 37 CFR § 1.56 and in accordance with 37 CFR §§ 1.97-1.98, information relating to the above-identified application is hereby disclosed. Inclusion of information in this statement is not to be construed as an admission that this information is material as that term is defined in 37 CFR § 1.56(b).



In accordance with § 1.97(b), since this Information Disclosure Statement is being filed either within three months of the filing date of the above-identified application, within three months of the date of entry into the national stage of the above identified application as set forth in § 1.491, before the mailing date

of a first Office Action on the merits of the above-identified application, or before the mailing date of a first Office Action after the filing of request for continued examination under § 1.114, no additional fee is required.

- ☐ In accordance with § 1.129(a), this Information Disclosure Statement is being filed in connection with ☐ the first or ☐ second After Final Submission, therefore:

☐ Certification in Accordance with § 1.97(e) is attached; or

☐ The fee of \$180.00 as set forth in § 1.17(p) is attached.

- ☐ In accordance with § 1.97(c), this Information Disclosure Statement is being filed after the period set forth in § 1.97(b) above but before the mailing date of either a Final Action under § 1.113 or a Notice of Allowance under § 1.311, or before an action that otherwise closes prosecution in the application, therefore:

☐ Certification in Accordance with § 1.97(e) is attached;

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☐ The fee of \$180.00 as set forth in § 1.17(p) is attached.

- ☐ In accordance with § 1.97(d), this Information Disclosure Statement is being filed after the mailing date of either a Final Action under § 1.113 or a Notice of Allowance under § 1.311 but before, or simultaneously with, the payment of the Issue Fee, therefore included are: Certification in Accordance with § 1.97(e); and the submission fee of \$180.00 as set forth in § 1.17(p).

- ☐ Copies of each of the references listed on the attached Form PTO-1449 are enclosed herewith.

- ☒ Copies of references 4-121 and 143-151 listed on the attached Form PTO-1449 are enclosed herewith
- ☒ Copies of references 122-142 listed on the attached Form PTO 1449 are not required to be submitted pursuant to the June 30, 2003 revisions to 37 CFR § 1.98(a)(2)(i).

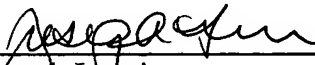
EXCEPT THAT:

- ☐ In view of the voluminous nature of references [list as appropriate], and the likelihood that these references are available to the Examiner, copies are not enclosed herewith.
- ☐ In accordance with § 1.98(d), copies of the following references listed on the attached Form PTO-1449 are not enclosed herewith because they were previously cited by or submitted to the U.S. Patent and Trademark Office in patent application(s) for which a claim for priority under 35 U.S.C. § 120 have been made in the instant application:
- ☐ Copies of references [list as appropriate] listed on the attached Form PTO-1449 were previously cited by or submitted to the Patent and Trademark Office in prior Application No. _____, filed _____.

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- ☒ The relevance of those listed references which are not in the English language is as follows: Reference 48 was cited in the Australian Patent Office search report in related application AT 9605733-6, dated March 1999 (reference 109) as a document defining the general state of the art that was not considered to be of particular relevance.
- ☒ English language abstracts or translations have been provided for references 10-14, 18, 21, 22, 27, 31-34, 36, 37, 42-44, 47, 49, 52-55, 57-62, 65, 67-71, 75-77, 81-85, 87, 89, 91, 99-102, 105, 108, and 110 which are not in the English language.

Date: MARCH 11, 2004



Joseph Lucci
Registration No. 33,307

WOODCOCK WASHBURN LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439



Form PTO-1449 Modified List of Patent and Publications Cited by Applicant (Use several sheets if necessary) U.S. Department of Commerce Patent and Trademark Office		Docket No. ORTU-0007	Application No. 10/761,096
		Applicant Robert Raffa, et al.	
		Filing Date January 20, 2004	Group Not Yet Assigned
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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)			
	4	Abramowicz M., (Ed.), "Drug treatment of cancer pain," <i>Med. Lett. Drugs Ther.</i> , October 29, 1982 24(621), 2 pages	
	5	Barth H., et al., "Anaphylactoid reactions and histamine release do not occur after application of the opioid tramadol," <i>Agents and Actions</i> , 1987, 20(3/4), 310-313.	
	6	Beaver W.T., "Aspirin and Acetaminophen as Constituents of Analgesic Combinations," <i>Arch. Intern. Med.</i> , 1981, 141, 293-300	
	7	Beaver W.T. "Combination Analgesics," <i>Am. J. Med.</i> , September 10, 1984, 77(3A), 38-52	
	8	Beaver W.T., "Impact of Non-Narcotic Oral Analgesics on Pain Management," <i>Am. J. Med.</i> , 1988, 84(suppl 5A), 3-15	
	9	Beaver, W.T., OTC Combination Analgesics – The Issue of Efficacy, <i>AAS Agents and Actions Supplements</i> , Birkhauser Verlag, Basel, 1988, 25, 49-67	
	10	Besel K., "Tumor-Schmerztherapie: Postskriptum [The Treatment of Tumor Pain: A Postscript]," <i>Münch. med. Wschr.</i> , 1985, 127(35), C17 (English abstract)	
	11	Beyer A., et al. "Heutige Vorstellungen zur Entstehung und Behandlung des Schmerzes [Current Understanding of the Origination and Treatment of Pain]," <i>Chirurg</i> , 1990, 61(7), 494-501 (English translation – Exhibit A)	
	12	Biscopig J., "Postoperative Schmerzbehandlung [Postoperative Pain Therapy]," <i>Med. Welt</i> , 1988, 39, 814-818 (English translation – Exhibit A)	
	13	Blaha L., "Pharmakotherapie der Schmerzzustände [Pharmacotherapy of pain]," <i>Med. Welt.</i> , 1980, 31(36), 1271-73 (English abstract)	
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	14	Brinkmann J., "Analgetikatherapie bei Tumorpapienten in der Praxis [Analgetic Therapy in Tumor Patients in Practice]," <i>Z. Allg. Med.</i> , 1989 , 65, 166-68 (English translation - Exhibit A)	
	15	Brown P., et al., "Tramadol Hydrochloride: Efficacy compared to codeine sulfate, acetaminophen with dextropropoxyphene and placebo in dental-extraction pain" <i>Eur. J. Pharmacol.</i> , 1990 , 183, page 1441	
	16	Carasso R.L., et al., "The Prevention and Treatment of Migraine with an Analgesic Combination," <i>Br. J. Clin. Pract.</i> , 1984 , 38, 25-27	
	17	Chaturachinda K., et al., "A Comparative Study of Tramadol and Pethidine in Laparoscopic Interval Sterilization," <i>J. Med. Assn. Thai.</i> , 1988 , 71(Suppl. 1), 55-57	
	18	Chrubasik J., et al., "Zur Schmerzbehandlung bei Karzinompatienten [On Pain Therapy in Carcinoma Patients]," <i>Z. Allg. Med.</i> , 1986 , 62, 792-797 (English translation - Exhibit A)	
	19	Coelho J.C.U., et al., "Effect of Analgesic Drugs on the Electromyographic Activity of the Gastrointestinal Tract and Sphincter of Oddi and on Biliary Pressure," <i>Ann. Surg.</i> , 1986 , 204(1), 53-58	
	20	Cooper S.A., et al., "Evaluation of oxycodone and acetaminophen in treatment of postoperative dental pain," <i>Oral Surg.</i> , 1980 , 50(6), 496-501	
	21	Cossmann M., et al., "Behandlung länger andauernder Schmerzsyndrome Beurteilung der Wirkung und Verträglichkeit von Tramadol (Tramal®) bei mehrmaliger Gabe [Treatment of Prolonged Severe Pain. Efficacy and Tolerance of Repeated Administration of Tramadol (Tramal®)]," <i>Münch. med. Wschr.</i> , 1987 , 129(46), 851- 854 (English abstract)	
	22	Dambacher M.A., "Therapie der Osteoporose [Therapy of osteoporosis]," <i>Dtsch. med. Wschr.</i> , 1983 , 108(18), 710-713 (English abstract)	
	23	Dawson K.S., et al., "A Statistical Test for Detecting and Characterizing Departures From Additivity in Drug/Chemical Combinations," <i>J. Ag. Biol. Env. Stat.</i> , 2000 , 5(3), 342-359	
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	24	De Conno F., et al., "A Clinical Study on the Use of Codeine, Oxycodone, Dextropropoxyphene, Buprenorphine, and Pentazocine in Cancer Pain," <i>J. Pain Sympt. Mgmt.</i> , 1991, 6(7), 423-427
	25	Derwent WPI database, accession no. 79-64031B, 1979, Abstract of JP 54-92631, 1 page
	26	Desjardins P.J., et al., "Efficacy of Low Dose Combination Analgesics: Acetaminophen/ Codeine, Aspirin/ Butalbital/ Codeine, and Placebo in Oral Surgery Pain," <i>Anesth. Prog.</i> , 1986, 33(3), 143-146
	27	Dick W., "Schmerztherapie, eine interdisziplinäre Aufgabe (Analgetika) [Pain therapy, an interdisciplinary problem (analgesics)]," <i>Wien. Med. Wschr.</i> , 1983, 133, 7-10 (English abstract)
	28	DiGregorio G.J., et al., "Pharmacologic Management of Pain," <i>Am. Fam. Phys.</i> , 1983, 27(5), 185-188
	29	Dimpfel W., et al., "Dose- and Time-Dependent Action of Morphine, Tramadol and Flupirtine as Studied by Radioelectroencephalography in the Freely Behaving Rat," <i>Neuropsychobiol.</i> , 1988, 20, 164-168
	30	Dionne R.A., et al., "Suppression of Postoperative Pain by Preoperative Administration of Ibuprofen in Comparison to Placebo, Acetaminophen, and Acetaminophen Plus Codeine," <i>J. Clin. Pharmacol.</i> , 1983, 23(1), 37-43
	31	Doenicke A., et al., "Chronische Schmerzen: Therapeutischer Beitrag der Anästhesisten [Chronic Pain: The Therapeutic Contribution of Anesthesiologists]," <i>Fortschritt Fortbildung Med.</i> , 1980, 13(90), 263-266 (English translation - Exhibit A)
	32	Engelhardt R., "Chemotherapie beim Bronchialkarzinom [Chemotherapy in Bronchial Carcinoma]," <i>Therapiewoche</i> , 1987, 37, 4663-4666 (English translation - Exhibit A)
	33	Fassolt A., "Tramal® (Tramadol) zur Schmerztherapie in der postoperativen Frühphase," <i>Schweiz. Rundschau Med. (PRAXIS)</i> , 1980, 69, 1495-1500 (English abstract)
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	34	Felder M., et al., "Die Behandlung der Schmerzen bei Osteoporose," <i>Schweiz. med. Wschr.</i> , 1982 , 112(2), 60-64 (English abstract)
	35	Ferrer-Brechner T., et al., "Combination Therapy with Ibuprofen and Methadone for Chronic Cancer Pain," <i>Am. J. Med.</i> , 1984 , 77(1A), 78-83
	36	Fischer M.V., et al., "Schmerztherapie beim Tumorpatienten [Treatment of Pain in Tumour Patients]," <i>Anästh. Intensivther. Notfallmed.</i> , 1986 , 21, 78-81 (English abstract)
	37	Flicoteaux H., et al., "Analgesie et Anesthésie "ambulatoires" [Analgesia and ambulatory anesthesia]" <i>Conv. Méd.</i> , 1986 , 5(4/5), 325-329 (English abstract)
	38	Foley K.M., "The treatment of cancer pain," <i>New. Engl. J. Med.</i> , 1985 , 313(2), 84-95
	39	Foley K.M., et al., "Analgesic Drug Therapy in Cancer Pain: Principles and Practice," <i>Med. Clinics N. Amer.</i> , 1987 , 71(2), 207-232
	40	Forbes J.A., et al., "An evaluation of the analgesic efficacy of three opioid-analgesic combinations in postoperative oral surgery pain," <i>J. Oral Surg.</i> , 1981 , 39, 108-112
	41	Forbes J.A., et al., "Nalbuphine, acetaminophen, and their combination in postoperative pain," <i>Clin. Pharmacol. Ther.</i> , 1984 , 35(6), 843-851
	42	Frei F.J., et al., "Perioperative Schmerztherapie im Kindesalter: Konzepte und Realisierung," <i>Eur. J. Pain</i> , 1991 , 12(1), 12-19 (English Abstract)
	43	Freye V.E., "Opiate und Opiatantagonisten: II. Dep praktische Einsatz der Opioide [Opiates and opiate antagonists: Part 2. Practical use of opioids].," <i>Deutsche Apotheker Zeitung</i> , 1991 , 131(49), 2605-2615 (English abstract)
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	44	Ganzer U., et al., "Die Schmerzbehandlung bei fortgeschrittenen Geschwülsten der Kopt-Hals-Region [Treatment of Pain in Advanced Head and Neck Cancer]," <i>Laryng. Rhinol. Otol.</i> , 1988 , 67(3), 90-93 (English translation)	
	45	Gilman A. et al., eds. "Para-aminophenol derivatives," <i>Goodman & Gilman's The Pharmacological Basis of Therapeutics</i> , 6th ed., 1980 , Chapter 29, 701-705	
	46	Grond S., et al., "Tramadol – a weak opioid for relief of cancer pain," <i>The Pain Clinic</i> , 1992 , 5(4), 241-247	
	47	Hackenthal E., "Therapie mit Analgetika und Antirheumatika im Alter [Therapy with analgesics and anti-rheumatic agents in the aged]," <i>Verh. Dtsch. Ges. Inn. Med.</i> , 1990 , 96, 274-285 (English abstract)	
	48	Helwig B., "Analgetica," <i>Moderne Arzneimittel</i> (Stuttgart: Wissenschaftliche Verlagsgesellschaft mbH), 5th ed, 1980 , 1-46	
	49	Hempel V., et al., "Postoperative Schmerzbehandlung in der Chirurgie [Postoperative pain treatment in surgery]," <i>Chirurg</i> , 1983 , 54(12), 769-774 (English translation – Exhibit A)	
	50	Hennies H.-H., et al., "Receptor Binding, Analgesic and Antitussive Potency of Tramadol and Other Selected Opioids," <i>Arzneim. Forsch. / Drug Res.</i> , 1988 , 38(7), 877-880	
	51	Hinson J.A., "Reactive Metabolites of Phenacetin and Acetaminophen: A Review," <i>Env. Health Perspec.</i> , 1983 , 48, 71-79	
	52	Hotz G., et al., "Analgetika in der zahnärztlichen Praxis [Analgesics in Dental Practice]," <i>ZWR</i> , 1985 , 94(11), 892-896 (English translation – Exhibit A)	
	53	Hövel M., et al., "Knochenmetastasen – operative, orthetische und analgetische Behandlungsrichtlinien [Bone Metastases – Operative, Orthotic, and Analgetic Guidelines of Treatment]," <i>Orthop. Praxis</i> , 1989 , 5/89, 284-290 (English abstract)	
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	54	Huhn D., "Bedürfnisorientierte Therapie vermeidet Angst und Depression [Need-oriented therapy prevents fear and depression]," <i>Therapiewoche</i> , 1991, 41, 1918-1923 (English translation – Exhibit A)	
	55	Isele H., "Tumor-Schmerztherapie [Algotherapy in Tumour Patients]," <i>Munch. med. Wschr.</i> , 1985, 127(35), 821-823 (English abstract)	
	56	Keinänen S., "Antipyretic Therapy. Comparison of Rectal and Oral Paracetamol," <i>Eur. J. Clin. Pharmacol.</i> , 1977, 12, 77-80	
	57	Krimmer H., et al., "Die kombinierte Infusionsanalgesie – Ein alternatives Konzept zur postoperativen Schmerztherapie [Combined infusion analgesia – an alternative concept in postoperative pain therapy]," <i>Chirurg</i> , 1986, 57(5), 327-329 (English abstract)	
	58	Lehmann K.A., "Opiate in der Kinderanaesthesie [Narcotic analgesics in pediatric anesthesia]," <i>Anaesthesist</i> , 1990, 39(4), 195-204 (English abstract)	
	59	Lierz P., et al., "Aurwachverhalten bei verschiedenen Analgosedierungsschemata [Time Course of Recovery from Different Analgesic and Sedative Therapies]," <i>Klin. Wochenschr.</i> , 1991, 69(Suppl. xxvi), 84-88 (English abstract)	
	60	Luckhaupt H., "Schmerztherapie beim Patienten mit inkurablen Kopf-Hals-Tumoren [Treatment of pain in patients with incurable head and neck tumors]," <i>HNO</i> , 1989, 11 465-468 (English translation – Exhibit A)	
	61	Luckhaupt H., "Medikamentöse Schmerztherapie bei Patienten mit fortgeschrittenen Kopf-Hals-Tumoren [Drug pain therapy in patients with advanced head-neck tumors]," <i>Laryng. Rhinol. Otol.</i> , 1990, 69, page 663 (English abstract)	
	62	Luckhaupt H., et al., "Medikamentöse und nicht-medikamentöse Tumorschmerztherapie in der HNO-Heilkunde [Pain Therapy in Patients with Cancer of the Head and Neck]," <i>Laryng. Rhinol. Otol.</i> , 1991, 70, 683-685 (English abstract)	
	63	McQuay H.J., et al., Codeine 20 mg increases pain relief from ibuprofen 400 mg after third molar surgery. A repeat-dosing comparison of ibuprofen and an ibuprofen-codeine combination," <i>Pain</i> , 1989, 37, 7-13	
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	64	Mehlish D.R., et al., "Tramadol hydrochloride: efficacy compared to codeine sulfate, acetaminophen with dextropropoxyphene and placebo in dental-extraction," <i>Pain Suppl.</i> , 1990, 5, page S41, Abstract Number 76	
	65	Meier P.J., et al., "Medikamentöse Schmerztherapie [Medicinal Pain Therapy," <i>Therapeut. Umschau</i> , 1989, 48(8), 526-536 (English translation – Exhibit A)	
	66	<i>Merck Index</i> , 11th ed. 1989, pages 8 and 1506. Acetaminophen (no. 40) and Tramadol (no. 9485).	
	67	Mikić, B., et al., "Klinicko Ispitivanje Analgetika »Tramadol « u olbiku za oralnu upotrebu [Clinical investigation of the Analgetic "Tramadol" in the form for oral use]," <i>Acta orthop. Jugosl.</i> , 1985, 16(3), 93-96 (English translation – Exhibit A)	
	68	Montéfiore A., et al., "Comparaison du Tramadol a l'association dextropropoxyphene + paracetamol dans le traitement de la douleur post-operatoire," <i>Thérapie</i> , 1991, 46, 491-495, Abstract Number 15 (English abstract)	
	69	Morant R., et al., "Pharmakokinetische Einflüsse auf die Morphintoxizität mit Fallbeispielen [Pharmacokinetic Influences on Morphine Toxicity with Case Studies]," <i>Schweiz. Rundschau Med. (praxis)</i> , 1991, 80(26), 719-722 (English translation – Exhibit A)	
	70	Müller H. et al., "Hämodynamische und respiratorische Effekte von Tramadol bei Lachgas-Sauerstoff-Beatmung und in der postoperativen Phase [Effects of Tramadol on Haemodynamics and Respiration During N ₂ O-O ₂ Ventilation and in the Postoperative Period]," <i>Anaesthesist</i> , 1982, 31, 604-610 (English abstract)	
	71	Müller-Plettenberg D., "Chronische Schmerzzustände – Infektiöse Darmerkrankungen – Harnwegsinfekte [Chronic Pain Conditions – Infectious Intestinal Diseases – Urinary Tract Infections]," <i>Braun Therapiewoche</i> , 1984, 34(11), 1685-1687 (English translation – Exhibit A)	
	72	Nickel B., "The antinociceptive activity of flupirtine: a structurally new analgesic," <i>Postgrad. Med. J.</i> , 1987, 63, 19-28	
	73	Padmasuta K., "Effects of Tramadol on postoperative wound pain in Thai patients," <i>Curr. Ther. Res.</i> , 1985, 38(2), 316-320	
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	74	Padmasuta P., et al., "The Efficacy of Tramadol in the Interval Laparoscopic Sterilization: A Comparison of Two Dosage Regimen," <i>J. Med. Assn. Thai.</i> , 1988 , 71(Suppl. 2), 61-63	
	75	Peikert V.A., et al., "Systemische Pharmakotherapie bei Kruezscherz [Systemic Drug Therapy of Low Back Pain – Indications and Practical Application]," <i>Fortschr. Med.</i> , 1989 , 107(18), 403-405 (English abstract)	
	76	Polák J., et al., "Terapie Nadorove bolesti [Tumour Pain Therapy]," <i>Sborn. lek.</i> , 1988 , 90(11-12), 358-363 (English translation – Exhibit A)	
	77	Porges P., "Moderne Trends in der Krebscherztherapie [Modern trends in cancer pain therapy]," <i>Arch. Geschwulstforsch.</i> , 1991 , 61(1), 17-21 (English translation)	
	78	Preston K.L., et al., "Effects of Tramadol in Humans: Assessment of its Abuse Potential," <i>Natl. Inst. Drug Abuse Res. Mono. Ser.</i> , 1989 , 95, page 392	
	79	Preston K.L., et al. "Abuse potential and pharmacological comparison of tramadol and morphine," <i>Drug Alc. Depend.</i> , 1991 , 37, 7-17	
	80	Richter W., et al., "Clinical Investigation on the Development of Dependence during Oral Therapy with Tramadol," <i>Arzneim. Forsch. / Drug Res.</i> , 1985 , 35(11), 1742-1744	
	81	Schlunk T., et al., "Schmerz und Schmerztherapie bei Tumorpatienten [Pain and Pain Therapy for Tumor Patients]," <i>Med. Welt.</i> , 1990 , 41, 297-303 (English translation – Exhibit A)	
	82	Schönhöfer P.S. "Möglichkeiten und Grenzen einer pharmakologischen Beeinglussung der Muskulatur [Capabilities and Limits of Pharmacological Manipulation of the Musculature]," <i>Verb. Dtsch. Ges. Rheumatol.</i> , 1981 , 7, 49-52 (English translation – Exhibit A)	
	83	Schoon W., et al., "Grundlagen der Pharmakotherapie tumorinduzierter Schmerzsyndrome [Fundamentals of Pharmacotherapy of Tumor-Induced Pain Syndrome]," <i>Med. Klin.</i> , 1987 , 82(23), 824-831 (English translation – Exhibit A)	
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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)			
	84	Seitz W., "Endokrine Reaktionsmuster im Verlauf der einphasigen Tramadol-N ₂ O-Kombinationsnarkose [Effects of Tramadol-N ₂ O-Anaesthesia and Surgery on the Endocrine System]," <i>Anästh. Intensivther. Notfallmed.</i> , 1982 , 17, 325-331 (English abstract)	
	85	Senn H.J., "Das Schmerzproblem in der Onkologie [The problem of pain in oncology]," <i>Schweiz. med. Wschr.</i> , 1990 , 120(31/32), 1135-1142 (English translation – Exhibit A)	
	86	Sonne J., et al., "Therapeutic Doses of Codeine Have no Effect on Acetaminophen Clearance or Metabolism," <i>Eur. J. Clin. Pharmacol.</i> , 1988 , 35, 109-111	
	87	Sorge J., et al., "Schmerztherapie beim gynäkologischen Malignomen [Pain Therapy in Patients with Gynaecological Cancer]," <i>Geburtsh. u. Frauenheilk.</i> , 1990 , 50(2), 93-100 (English translation – Exhibit A)	
	88	Stacher G., et al., "Effects of tolmetin, paracetamol, and of two combinations of tolmetin and paracetamol as compared to placebo on experimentally induced pain. A double blind study," <i>Int. J. Clin. Pharmacol. Biopharm.</i> , 1979 , 17(6), 250-255	
	89	Staehler G., "Die Harnleiterkolik [Renal Colic]," <i>Internist</i> , 1989 , 30, 110-113 (English abstract)	
	90	Staritz M., et al., "Electromagnetically generated extracorporeal shockwaves for fragmentation of extra- and intrahepatic bile duct stones: indications, success and problems during a 15 months clinical experience," <i>Gut</i> , 1990 , 31, 222-225	
	91	Strumpf M., et al., "Schmerztherapie bei Lungentumoren [Lung Cancer Pain Therapy]," <i>Atemw.-Lungenkrkh.</i> , 1989 , 15(3), 111-115 (English translation – Exhibit A)	
	92	Sunshine A., et al., "Analgesic oral efficacy of tramadol hydrochloride in postoperative pain," <i>Clin. Pharmacol. Ther.</i> , 1992 , 51(6), 740-746	
	93	Suvonnakote T., et al., "Pain Relief During Labour," <i>J. Med. Assn. Thai.</i> , 1986 69(11), 575-580	
EXAMINER		DATE CONSIDERED	



Form PTO-1449 Modified List of Patent and Publications Cited by Applicant (Use several sheets if necessary) U.S. Department of Commerce Patent and Trademark Office		Docket No. ORTU-0007	Application No. 10/761,096
		Applicant Robert Raffa, et al.	
		Filing Date January 20, 2004	Group Not Yet Assigned
		Confirmation No. Not Yet Assigned	
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)			
	94	Sveen K., et al., "Paracetamol/ codeine in relieving pain following removal of impacted mandibular third molars," <i>Int. J. Oral Surg.</i> , 1975 , 4, 258-266	
	95	Takeda F. "Results of field-testing in Japan of the WHO Draft Interim Guideline on Relief of Cancer Pain," <i>The Pain Clinic</i> , 1986 , 1(2), 83-89	
	96	Tallarida R.J., et al., ". Minireview – Statistical analysis of drug-drug and site-site interactions with isobolograms," <i>Life Sci.</i> , 1989 , 45(11), 947-961	
	97	Tallarida R.J., et al., "Testing for synergism over a range of fixed ration drug combinations: replacing the isobologram," <i>Life Sci.</i> , 1996 , 58(2), PL23-PL28	
	98	Tallarida R.J., "Analysis of Drug Combinations Over a Range of Drug Ratios," <i>Drug Synergism and Dose-Effect Data Analysis</i> , Chapman & Hall/CRC, Boca Raton, 2000 , Chapter 7, 123- 129	
	99	Terrahe K., et al., "Welche Analgetika empfehlen Sie nach der Tonsillektomie? [Which analgesics do you recommend following tonsillectomy?]," <i>Laryng. Rhinol. Otol.</i> , 1989 , 68, page 189, (English abstract)	
	100	Tigges F.-J., "Schmerzmittel bei Tumorerkrankungen [Analgesics in malignant disease]," <i>Therapiewoche</i> , 1984 , 34(24), 3713-3716 (English abstract)	
	101	Wang K.Y., "[Tramadol Fentanyl WSWL (Extracorporeal Shock Wave Lithotripsy)]," <i>Anaesth. Sinica</i> , 1989 , 27, 341-347 (English abstract)	
	102	Weber E., "Chirurgisch relevante Nebenwirkungen von Medikamenten: Analgetica [Surgery-related adverse effects drugs: analgesics].," <i>Chirurg</i> , 1981 , 52(2), 76-80 (English abstract)	
	103	World Health Organization, <i>Cancer Pain Relief</i> , Geneva, 1986 , 7-74	
EXAMINER		DATE CONSIDERED	



Form PTO-1449 Modified List of Patent and Publications Cited by Applicant (Use several sheets if necessary) U.S. Department of Commerce Patent and Trademark Office		Docket No. ORTU-0007	Application No. 10/761,096
		Applicant Robert Raffa, et al.	
		Filing Date January 20, 2004	Group Not Yet Assigned
		Confirmation No. Not Yet Assigned	
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)			
	104	Wörz R., "Control of Cancer Pain with Analgesics Acting in the Central Nervous System," <i>Recent Results Cancer Res.</i> , 1984 , 89, 100-106	
	105	Wörz R., et al., "Medikamentöse Therapie von Karzinomschmerzen [Medical Therapy of Cancer Pain]," <i>Med. Mo. Pharm.</i> , 1985 , 8(10), 292-300 (English translation – Exhibit A)	
	106	Yanagita T. "Drug Dependence Potential of 1-(m-Methoxyphenyl)-2-(dimethylaminomethyl)-cyclohexan-1-ol Hydrochloride (Tramadol) Tested in Monkeys," <i>Arzneim. Forsch. / Drug Res.</i> , 1978 , 28(1), 158-163	
	107	Young R.E.S., "A comparison of analgesic effectiveness of oral butorphanol / acetaminophen, oxycodone / acetaminophen and placebo in hospitalized postsurgical patients," <i>J. Med.</i> , 1979 , 10(6), 417-428	
	108	Zech D., "Medikamentöse Tumorschmerztherapie nach dem WHO-Stufenplan [Drug-based Tumor Pain Therapy in Accordance with the WHO Step-wise Plan]," <i>Dtsch. Z. Onkologie</i> , 1991 , 23, 85-92 (English translation – Exhibit A)	
	109	Austrian Patent Office search report in related application AT 9605733-6, dated 15 March 1999.	
	110	Japanese Patent Office examiner's action in related application JP 505447/93, dated 02 October 2001 (English translation).	
	111	Memorandum to G. Tutwiler from N. Landekic, Revised Tramadol [Business Opportunity] Analysis, with attachments, dated 19 August 1988 (in redacted form as produced in litigation).	
	112	<i>Ortho-McNeil Pharmaceutical, Inc. v. Kali Laboratories, Inc.</i> , No. CV-02-5707 (JCL) (D.N.J.), Complaint, 25 November 2002.	
	113	<i>Ortho-McNeil Pharmaceutical, Inc. v. Kali Laboratories, Inc.</i> , No. CV-02-5707 (JCL) (D.N.J.), Defendant's Answer and Counterclaim, 02 January 2003.	
EXAMINER		DATE CONSIDERED	



Form PTO-1449 Modified List of Patent and Publications Cited by Applicant (Use several sheets if necessary) U.S. Department of Commerce Patent and Trademark Office		Docket No. ORTU-0007	Application No. 10/761,096
		Applicant Robert Raffa, et al.	
		Filing Date January 20, 2004	Group Not Yet Assigned
		Confirmation No. Not Yet Assigned	
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)			
	114	<i>Ortho-McNeil Pharmaceutical, Inc. v. Kali Laboratories, Inc.</i> , No. CV-02-5707 (JCL) (D.N.J.), Deposition of Robert B. Raffa, 25 November 2003.	
	115	<i>Ortho-McNeil Pharmaceutical, Inc. v. Kali Laboratories, Inc.</i> , No. CV-02-5707 (JCL) (D.N.J.), Deposition of Jeffry L. Vaught, 08 January 2004.	
	116	Patent certification notice under FFDCA § 505(j)(2)(B)(ii) from Kali Laboratories to Ortho-McNeil Pharmaceuticals, dated 17 October 2002.	
	117	Patent certification notice under FFDCA § 505(j)(2)(B)(ii) from Teva Pharmaceuticals USA to Ortho-McNeil Pharmaceuticals, dated 22 January 2004.	
	118	R.W. Johnson Pharmaceutical Research Institute, Abbreviated Final Clinical Study Report, Tramadol Hydrochloride with Acetaminophen in Pain of Cesarean Section (Protocol CB), dated 13 April 1994.	
	119	R.W. Johnson Pharmaceutical Research Institute, Abbreviated Final Clinical Study Report, Tramadol Hydrochloride with Acetaminophen: Factorial Efficacy in Dental-Extraction Pain (Protocol CA), dated 23 June 1994.	
	120	R.W. Johnson Pharmaceutical Research Institute, Protocol CA – Phase II: Tramadol Hydrochloride with Acetaminophen: Factorial Efficacy in Dental-Extraction Pain (Protocol CA), dated 21 November 1989; with appended executed agreement signature page.	
	121	R.W. Johnson Pharmaceutical Research Institute, Protocol CB – Phase II: Tramadol Hydrochloride with Acetaminophen in Pain of Cesarean Section, dated 29 October 1990.	
EXAMINER		DATE CONSIDERED	



Form PTO-1449 Modified List of Patent and Publications Cited by Applicant (Use several sheets if necessary) U.S. Department of Commerce Patent and Trademark Office	Docket No. ORTU-0007	Application No. 10/761,096
	Applicant Robert Raffa, et al.	
	Filing Date January 20, 2004	Group Not Yet Assigned
	Confirmation No. Not Yet Assigned	

U. S. PATENT DOCUMENTS

Examiner Initial		Document No.	Date	Name	Class	Subclass
	122	2,770,569	11/13/56	Fromherz, et al.	167	65
	123	3,652,589	03/28/72	Flick, et al.	260	326.5
	124	3,773,955	11/20/73	Pachter, et al.	424	260
	125	4,132,788	01/02/79	Wong	424	232
	126	4,237,140 see JP 55-154917	12/02/80	Dudzinski	424	260
	127	4,260,629	04/07/81	Schmidt, et al.	424	274
	128	4,322,427	03/30/82	Buyniski, et al.	424	260
	129	4,571,400	02/18/86	Arnold	514	282
	130	4,601,894	07/22/86	Hanna, et al.	424	19
	131	4,631,284	12/23/86	Salpekar, et al.	514	277
	132	4,730,007	03/08/88	Ehrenpreis	514	561
	133	4,769,372	09/06/88	Kreek	514	282
	134	4,806,543	02/21/89	Choi	514	464
	135	4,829,064	05/09/89	Sunshine, et al.	514	255
	136	4,943,565	07/24/90	Tencza, et al.	514	161
	137	5,223,541	06/29/93	Maryanoff, et al.	514	644
	138	5,317,022	05/31/94	Borsodi, et al.	514	282

EXAMINER

DATE CONSIDERED



Form PTO-1449 Modified List of Patent and Publications Cited by Applicant (Use several sheets if necessary) U.S. Department of Commerce Patent and Trademark Office	Docket No. ORTU-0007	Application No. 10/761,096
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	Filing Date January 20, 2004	Group Not Yet Assigned
	Confirmation No. Not Yet Assigned	

U. S. PATENT DOCUMENTS

Examiner Initial		Document No.	Date	Name	Class	Subclass
	139	5,352,680	10/04/94	Portoghese, et al.	514	279
	140	5,468,744	11/21/95	Raffa, et al.	514	282
	141	5,516,803	05/14/96	Raffa	514	570
	142	6,562,865 B1	05/13/03	Codd, et al.	514	456

FOREIGN PATENT DOCUMENTS

Examiner Initial		Document No.	Date	Country	Translation	
					YES	NO
	143	0 017 102 A1 see JP 55-129225	10/15/80	EPO		
	144	0 227 836 B1	12/27/97	EPO		
	145	0 240 904 B1	07/01/92	EPO		
	146	0 358 105 B1	03/02/94	EPO		
	147	0 358 107 A2	03/14/90	EPO		
	148	54-92631	07/23/79	Japan	English abstract	
	149	55-129225 see EPO 0 017 102 A1	10/06/80	Japan	English-language equivalent	
	150	55-154917 see US 4,237,140	12/02/80	Japan	English-language equivalent	
	151	57-128626	08/10/82	Japan	English abstract	

EXAMINER

DATE CONSIDERED